

Appl. No. 10/656,489  
Docket No. 9355  
Amdt. dated 17 August 2006  
Reply to Office Action mailed on May 19, 2006  
Customer No. 27752

## REMARKS

### Claim Status

Claims 1-7, 10, 12-17 and 20 are pending in the present application. No additional claims fee is believed to be due.

### Rejection Under 35 U.S.C. §103(a) Over Taylor et al. (U.S. 6,258,075) in view of Kobler (U.S. 3,946,737)

Claims 1-7, 10, 12-17 and 20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Taylor et al. in view of Kobler.

With respect to claims 1-7, 10, 12-17 and 20 and obviousness: Applicants respectfully traverse the rejection of claims 1-7, 10, 12-17 and 20 as the cited references do not establish a *prima facie* case of obviousness. The Office Action on page 3 chooses to invoke "one of ordinary skill in the art" in order to supply a suggestion to combine or modify the teachings of the two cited prior art references. The BPAI was reversed on this very point in *In re Denis Rouffet, Yannick Tangury and Frederic Berthault*, 149 F.3d 1350 (1998 US App.). In reversing the Board, the CAFC relied on a well-established line of cases which establishes the principle, "When a rejection depends upon a combination of prior art references, there must be some teaching, suggestion or motivation to combine the references." Importantly, the CAFC made it very clear that recourse to "skill-in-the-art" is not sufficient basis for combining references under §103 obviousness standards. The Court further stated:

The Board's naked invocation of skill in the art to supply a suggestion to combine the references cited in this case is therefore clearly erroneous. Absent any proper motivation to combine [parts of the various references] the rejection of Rouffet's claim ...is reversed.

The Board was also reversed on this same point in the *In re Anita Dembizak and Benson Zinbarg*, 175 F.3d 994 (1999 US App.). Again, the Court noted:

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Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.

Moreover:

...this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the [cited references] teach or suggest their combination ... to yield the claimed invention.

The Board was reversed yet again on similar grounds in *In re Dow Chemical Company* 837 F.2d 469 (1998 US App.). Citing controlling case law, the Court stated:

The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. Both the suggestion and the expectation of success must be found in the prior art, not in the Applicant's disclosure.

Applicants respectfully submit that there is no suggestion or motivation provided in either Taylor et al. or Kobler to produce the tampon of the present invention. Taylor et al. does not disclose or suggest a finger indent located at the withdrawal end of its tampon or even the desirability of such an indent. Kobler does not disclose a finger indent located at the withdrawal end of a tampon, but rather, a tampon enclosed in a protective wrapper, called an umbrella wrapper, wherein the bulge in the middle section of the tampon serves as a stop and guide to hold the tampon at its middle section. (Col. 1, Lines 19-22) Further Kobler teaches away from the present invention in that it states, "To let the tampon slip out of the fingers is almost unavoidable, if the fingers grip the tampon underneath the protective umbrella only at its very end." (Col. 1, Lines 27-30) Therefore, Kobler discloses that to have a finger indent in the withdrawal end of the

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tampon so as to grip the tampon at its very end would cause the tampon to slip out of the fingers of the user. As such Kobler teaches away from the present inventive tampon, which comprises a finger indent located at the withdrawal end.

As neither Taylor et al nor Kobler provide any motivation or suggestion to one of ordinary skill in the art to produce the tampon of the present invention, Applicants respectfully submit that the Office Action fails to make out a *prima facie* case of obviousness for Claims 1-7, 10, 12-17 and 20.

#### Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §103. Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-7, 10, 12-17 and 20 is respectfully requested.

Respectfully submitted,

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Date: 17 August 2006  
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